REMARKS

Claims 1-8 and 17-50 are pending. Claims 1-8 were withdrawn and claims 9-16 were cancelled in previously entered amendments. Claims 17, 27, 39 and 44 have been amended to include the features of transferring message data from a first set top box to a video game server and from the video game server to a second set top box. Claims 17, 27, 39 and 45-50 have also been amended to more clearly describe the "player-defined parameter" of the invention. Claim 44 has been amended to correct a minor informality. No new matter has been added.

Applicants thank the Examiner for his careful review of the present application and amendments made in response to the non-final Office Action. In the final Office Action, the Examiner stated that certain features in amended claims 17, 27, 39 and 44 do not find support in the provisional application. However, Applicants note that the references cited by the Examiner in rejecting these independent claims were filed in the United States or published internationally before the filing of the provisional application. Therefore Applicants respectfully traverse the Examiner's conclusion and further assert that this issue is moot.

Applicants have amended claims 17, 27, 39 and 44 to include the features of transferring message data from a first set top box to a video game server and then to a second set top box. Applicants respectfully submit that none of the references cited by the Examiner, taken alone or in combination, disclose the transfer of a data message between set top boxes associated with a first and a second participant. As further described in the specification at p. 26, "the server system may serve as a transfer point for messages and data sent from one set top box to another during the course of the game. In such a system, the server may be operable to create a broadcast video signal of the game based on the messages sent from the set top boxes." Because these features are not disclosed in any of the references cited by the Examiner, Applicants respectfully request that the rejection of claims 17, 27, 39 and 44 be withdrawn.

Applicants have also amended claims 17, 27, 39 and 45-50 to more clearly describe that the player-defined parameter is provided by the first or second players. Applicants refer to the specification at p. 15 wherein it is described that "the participants have the option of selecting variables concerning the game to be played. For example...parameters for selecting other participants, and other variables may all be changed during this process."

Claims 17, 19-32 and 34-43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat (WO 99/00163). This rejection is respectfully traversed.

Independent claims 17, 27 and 39 include features directed to methods, systems and means for selecting at least one of the first and second players for a game based on at least one parameter provided by the first or second players. Applicants have reviewed the references cited by the Examiner and note that none of the references, taken alone or in combination, disclose this feature of independent claims 17, 27 and 39.

In the Office Action, the Examiner stated that Eilat discloses "selecting at least one of the first and second players for said interactive game based on at least one player-defined parameter." In support of the rejection, the Examiner cited Eilat at p. 5, ll. 1-4; p. 6, ll. 15-20; p. 18, l. 19 – p. 19, l. 5; p. 19, ll. 33-36; and p. 23, ll. 7-13. Applicants respectfully submit that the cited portions of Eilat do not disclose this feature of claims 17, 27 and 39.

Eilat at p. 5, ll. 1-4 discloses selecting a basic avatar from a group of avatars and confirming a selection of the avatar. The portion of Eilat cited at p. 6, ll. 15-20 also recites selecting a basic avatar, confirming a selection of the avatar and combining a picture of a player with the basic avatar. Applicants submit that the selection of an avatar does not teach the claimed feature because the selection of an avatar is not the selection of a user. The portion of Eilat cited at p. 18, l. 19 – l. 29 defines what the reference considers to be an avatar. An avatar is described as "an embodiment or personification, typically a video embodiment or personification, of a person which is typically combined with other video images in a virtual studio." The avatar of Eilat exists separately from a

player and can be merely a picture of a player or an animated character chosen to enhance the game playing experience (p. 18, l. 21-23). Applicants therefore submit that disclosure of an avatar in Eilat does not teach "selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second players."

The Examiner notes that Eilat discloses the selection of a player "by an audience that views the game show, by a manager of the game show, or automatically based on a predetermined criterion, such as previous game playing history of the viewer who wishes to be a player" (p. 19, 1-5). Applicants submit that none of these examples in Eilat show "selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second players." The cited portion of Eilat merely shows the selection of a player by someone or something that is not a player. However, there is no teaching in Eilat to suggest that the selection by an audience member, by a manager, using a predetermined criterion or using game playing history includes a parameter provided by a player. Applicants therefore submit that the cited portion does not show the selection of a player "based on at least one parameter provided by the first or second players."

Applicants submit that the Examiner's reference to Eilat at p. 23, ll. 7-13 also fails to disclose "selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second players." The portion cited by the Examiner discloses the selection of a viewer "performed by placing a telephone call to the viewer's residence and informing him of the selection, or by transmitting a selection message which is individually addressed to the viewer." The placement of a telephone call to a player also fails to identify any "parameter provided by the first or second players."

Applicants note that, while the Examiner also cited p. 19, ll. 33-36, this appears to be in error as p. 19 does not comprise 36 lines.

For at least the reasons given above, Applicants respectfully submit that Eilat does not, taken alone or in combination, disclose the feature of "selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second players." Applicants therefore request that the rejection of independent claims 17, 27 and 39 be withdrawn.

The Examiner rejected independent claim 44 under 35 USC 103(a) as being unpatentable over Eilat in view of Korilis (U.S. Patent No. 6,335,744). This rejection is respectfully traversed.

Claim 44 recites, in part, that "the registration of at least one of the first and second players is solicited through a television advertisement."

The Examiner noted that Korilis teaches a "game designed to lure computer users (players) to different websites." Applicants assert that Korilis discloses a system substantially different from the claimed system. While claim 44 describes the use of an advertisement to solicit game players to a game, Korilis discloses using a game to lure users to specified websites. Thus, the game in Korilis serves the opposite purpose of the game claimed in this application. Furthermore, Applicants respectfully submit that there is no motivation to combine Eilate with Korilis because not only would a combination of the two references fail to disclose the invention described in claim 44, but the combination would perform a function fundamentally different from that performed by the claimed invention.

Applicants further submit that, even if the references could be combined, they do not show, either alone or in combination, the use of a television advertisement to solicit registration of a user. Thus, Applicants respectfully submit that Eilat and Korilis do not, alone or in combination, disclose the feature of "the registration of at least one of the first and second players is solicited through a television advertisement" and, therefore, request that the rejection of claim 44 be withdrawn.

Claims 18-26, 28-38, 40-43 and 45-50 depend from independent claims 17, 27, 39 and 44. Applicants respectfully submit that they have shown the patentability of at least independent claims 17, 27, 39 and 44. Accordingly, claims 18-26, 28-38, 40-43 and 45-50 are themselves patentable

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insofar as they depend from patentably distinct independent claims. Applicants make this assertion without reference to the independent bases of patentability contained within each dependent claim. Accordingly, Applicants respectfully request the Examiner withdraw his rejections and allow all pending dependent claims.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 577172000300.

Dated: November 29, 2004

Respectfully submitted,

By_____
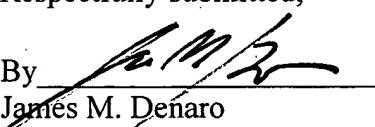
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